

REMARKS

This amendment is responsive to the office action dated June 12, 2006. Claims 1-24 are pending and are rejected. The claims are rejected based on 35 U.S.C. Section 103 as obvious. Reconsideration of the rejected claims is respectfully requested based on the amendments above and the argued urged below.

Affidavit and Declaration

In paragraphs 1-4, the Examiner refers to a declaration by Applicant, which was apparently submitted by prior counsel and indicates that it is ineffective because of a missing signature. The records transferred to the undersigned do not show an original declaration with a signature. Nor has the company been able to locate the inventor. Accordingly, for the purpose of this response, Parry is addressed as prior art.

35 U.S.C. § 112 Rejections

In paragraph 2 of the office action, the Examiner has rejected claims 6, 11, and 17 under 35 U.S.C. §112, first paragraph, because of insufficient antecedent basis for “the estimated position” in line 1. Claim 1 is amended to provide antecedence for “the estimated position.” Further, the Examiner indicates that claims 6, 11, and 17 are directed to “sending a reply to the location service indicating an incorrect estimated position,” but finds it unclear how this determination is performed.” The Examiner suggests that in “order to determine that the estimated position is incorrect, there is a need for a comparative element and the claims do not provide for this comparative element.” Applicant respectfully submits that each of claims 6, 11, and 17 do recite a comparative element.

35 U.S.C. § 103 Rejections

Governing Criteria

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03

To resolve the issue of patentability based on obviousness, the Examiner must not only look to the teaching in the asserted references that meets the claimed limitations, but must also point to the motivation in the asserted references that invites a combination in the event one reference is devoid of a particular teaching. Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993).

An examiner may often find every element of a claimed invention in the prior art. “Virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents

would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonic, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

Discussion of 103 Rejections

The Examiner has rejected claims 1-5, 7-10, 12-16, and 18-24 under 35 U.S.C. §103(a) as being unpatentable over Belcca (U.S. Patent No. 6,728,545) in view of Negishi (U.S. Patent No. 5,974,330). Regarding claims 1, 7, 12, 18, 24, the Examiner takes the position that Belcca discloses all the limitations of the claims except for the following steps:

- 1) sending a location request to location service accessible through the network accessed wirelessly by the mobile device;
- 2) accessing a database of known device;
- 3) correlating the list of addresses with zone information of the database.

According to the Examiner, Negishi, in the same field of endeavor, teaches a method of determining the location of a mobile terminal based on the identification received by a base station. Also, the Examiner believes that Negishi, further discloses a method of:

- 1) sending a location request to host/location service accessible through the network
- 2) accessed wirelessly by the mobile device; col. 2, lines 14-64, col. 4, line 55 - col. 5, line 3
- 3) accessing a database of known device; see col. 5, lines 4-8 - correlating the list of addresses with zone information of the database; col. 2, lines 14-26 and col. 5, lines 34-51

Based on this reasoning, the Examiner asserts that it would have been obvious to one with ordinary skill in the art at the time the invention was made, to provide the above teachings of Negishi to Belcea in order to obtain an approximate position of the mobile station.

Applicant respectfully submits that the combination that the Examiner suggests is improper because the patent to Belcea is not prior art. It has a filing date of November 16, 2001, which is after the filing date of the present application, which is May 30, 2001. The Examiner is respectfully requested to withdraw the rejection of claims 1-5, 7-10, 12-16, and 18-24 as obvious of Belcea in view of Negishi.

The Examiner has rejected claim 19 under 35 U.S.C. §103(a) as being unpatentable over Belcca and Negishi in view of Parry (U.S. Patent Publication No. 2002/0164997). The Examiner takes the position that regarding claim 19, Belcea and Negishi disclose all the limitations as claimed, however, they do not disclose a method of including a bluetooth transceiver in the wireless device. According to the Examiner, Parry, in the same field of endeavor, teaches the use of bluetooth transceiver in the wireless device. See page 3, paragraph 28. As indicated above, the combination that the Examiner suggests is improper because the patent to Belcea

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is not prior art. It has a filing date of November 16, 2001, which is after the filing date of the present application, which is May 30, 2001. The Examiner is respectfully requested to withdraw the rejection of claim 19.

Conclusion

Applicant respectfully requests the Examiner to reconsider the application and to withdraw the rejections. In the event any issues remain, the Examiner is invited to telephone the undersigned representative to expedite allowance of this application.

Respectfully submitted,

BERRY & ASSOCIATES P.C.

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